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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,228	12/16/2003	Valerie Merle Friesen	82910-2602 ADB	3156
23529	7590	01/28/2005	EXAMINER	
ADE & COMPANY 1700-360 MAIN STREET WINNIPEG, MB R3C3Z3 CANADA			CARTER, MONICA SMITH	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

10/736,228

Applicant(s)

FRIESEN ET AL. 

Examiner

Monica S. Carter

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspond nce address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 20, "the four parts" lack proper antecedent basis.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: in line 12, "second substrate sheets" should be replaced with "second substrate sheet". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-7 and 9-12 are rejected under 35 U.S.C. 102(a) as being anticipated by Speyer (2003/0098579).

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Speyer discloses a portable media for confidential information comprising a first substrate (1) having a front and rear surface; a second substrate (1') separate from the first substrate sheet (as seen in figure 1) having a front and rear surface; the first substrate being arranged with the rear surface overlying the front surface of the second substrate; a fastening material fastening the overlying first and second substrates together along a line (see page 1, col. 2, [0017] and figure 1).

Speyer discloses that the media may be sealed on any part of its surface, "to make it possible to vary the shape of said medium as required" (see [0017]). This would, therefore, include the line being spaced from side edges of the first substrate sheet so as to define two parts of the first substrate sheet one on each side of the line and the line being spaced from side edges of the second substrate sheet so as to define two parts of the second substrate sheet one on each side of the line. The four parts defined by the two parts of the first substrate sheet and the second substrate sheet being would be separable from each other except along the sealed line such that each part can pivot relative to the other parts about an axis that is defined by the seal line.

Speyer further discloses that the first substrate can be folded about the line (7) to bring the two parts together (as seen in figure 2); so as to form a booklet of four sheet and eight surfaces; the substrates being printed with confidential information and game indicia printed on the surfaces and being covered by a layer of scratch-off material (see page 2, col. 2, [0035]).

The game indicia being printed by variable image printing and the first and second substrates being supplied in an initial condition for dispensing in a flat unfolded

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condition do not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Speyer.

Speyer discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the substrates, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of substrate does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional

relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

8. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speyer in view of Scrymgeour et al. ('885).

Speyer discloses the claimed invention except for game ticket constructions being connected to each other and having transverse rows of perforations dividing each from the next and fan folded for dispensing.

Scrymgeour et al. disclose a game ticket construction wherein a plurality of game tickets are connected to each other and have transverse rows of perforations (132) dividing each from the next (as seen in figure 5) and fan folded (as seen in figure 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Speyer's invention to include a plurality of game tickets connected by perforations, as taught by Scrymgeour et al., to enable the tickets to be carried on a continuous web of material.

### ***Response to Arguments***

9. Applicant's arguments filed September 21, 2004 have been fully considered but they are not persuasive.

Applicant argues that Speyer fails to disclose the first and second substrate sheets being separate each from the other since the sheets are connected together as

a single substrate folded at line 7. The examiner asserts that applicant has failed to claim that the first and second substrate sheets are completely separate sheets that are subsequently joined together. As claimed, applicant merely discloses first and second substrate sheets that are separate each from the other. As seen in figure 1, the first substrate sheet is separate from the second substrate sheet in the central area of the medium.

Applicant argues that Speyer fails to disclose the line at which the first and second substrate sheets are fastened together being spaced from the side edges of the sheets defining two parts of the first and second substrate sheets. The examiner maintains that Speyer discloses providing the seal "on any part of its surface" ([0017]). This would, therefore, include the seal line being spaced from the sided edges of the sheets defining two parts of the first and second substrate sheets. By locating the seal line in this desired location, each part would be capable of pivoting relative to the other parts about an axis defined by the line.

Even though applicant has not responded to the use of Scrymgeour et al. in the rejections, it is noted that Scrymgeour et al. has been used for solely disclosing a game ticket having transverse rows of perforations dividing each from the next and fan folded for dispensing and has not been relied upon for disclosing any of the other claimed limitations.

For the reasons as set forth above, the rejections are maintained.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (571) 272-4475. The examiner can normally be reached on Monday-Thursday (6:00 AM - 3:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 26, 2005

*Monica S. Carter*

**MONICA S. CARTER  
PRIMARY EXAMINER**